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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,313	11/17/2003	Keith A. Thuerk	BOC9-2003-0033 (402)	5100
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AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER GOODCHILD, WILLIAM J	
			ART UNIT	PAPER NUMBER
			2145	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/715,313	THUERK, KEITH A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William J. Goodchild	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/05/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-35 can be considered to be software in accordance with applicants specification, (page 14, paragraph 46, "The present invention also can be embedded in a computer program product, which comprises all the features enabling the implementation of the methods described herein, and which when loaded in a computer system is able to carry out these methods.")). In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6-20 and 24-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Landon, Deb, Del Valle, Sergio, Piza, Jazmin, Rush, Leif, "Deploying Lotus Sametime on the eserver iSeries Server", Redbooks, June 2002, (hereinafter Lotus Sametime).

In reference to claims 1, 19 and 34, Lotus Sametime teaches a method / system comprising:

providing a collaborative computing system comprising at least one instant messaging client, (page 2, 1.1, page 65, figure 3-46, Sametime Connect for the desktop, Exchange messages with AOL Instant Messenger users);

initializing said instant message client within a graphical user interface of said collaborative computing system, (page 136, 5.2.1);

receiving a search initializing action from said graphical user interface, (page 201, Creating a buddy list and group);

responsive to said receiving step, presenting search input fields within said graphical user interface, (page 201, figure 6-7);

receiving input via said input fields that specifies a search pattern, (page 201, figure 6-7 and Creating a buddy list and group);

searching at least one record source for online entities that satisfy said search pattern, (page 201, step 2-3); and

displaying a search result from said searching step within said graphical user interface, (page 201, step 2).

In reference to claims 2 and 20, Lotus Sametime teaches the method / system of claims 1 and 19 wherein:

said collaborative computing system is a Lotus Sametime (TM) type system, (page 15).

In reference to claims 6 and 24, Lotus Sametime teaches the method / system of claims 1 and 19 further comprising:

establishing a plurality of user specific search patterns; and recording said search patterns so that said search patterns can be retrieved at a later time, (page 126, 1<sup>st</sup> paragraph and figure 4-22, Search filters).

In reference to claims 7 and 25, Lotus Sametime teaches the method / system of claims 1 and 19 wherein:

said record source comprises a first database that is a record source specifying at least one online entity and a second database having a data field, wherein said data field specifies an attribute relating to said online entity that is not specified within said first database, said searching step further comprising the steps of:

establishing a query that includes said data field; and searching for at least one online entity using said query, (page 126, figure 4-22, field search filter for resolving person or groups and table 4-5).

In reference to claims 8 and 26, Lotus Sametime teaches the method / system of claims 1 and 19 further comprising:

specifying a plurality of record sources, each of which specifies at least one online entity, wherein said searching step further comprises searching said plurality of record sources for online entities that satisfy said search pattern, (page 120, table 4-2, Description of Field "Host Name or IP address of the LDAP server").

In reference to claims 9 and 27, Lotus Sametime teaches the method / system of claims 8 and 26 further comprising:

establishing at least one search preference that is used when performing said searching step, wherein said search result is based at least in part upon said search preference, (page 122, table 4-3, Field 'People').

In reference to claims 10 and 28, Lotus Sametime teaches the method / system of claims 8 and 26 further comprising:

establishing an order in which said record sources are accessed during said searching step, (page 120, table 4-2, Field "Position of this server in the search order").

In reference to claims 11 and 29, Lotus Sametime teaches the method / system of claims 1 and 19 further comprising:

directly executing at least one software-enhanced communication involving said online entity and a user of said graphical user interface using said search result, (page 9, 1.3.3, 4<sup>th</sup> and 5<sup>th</sup> paragraphs).

In reference to claims 12, 30 and 35, Lotus Sametime teaches a method / system comprising:

receiving a user specified search pattern, (page 125, #'s 11-12);

searching a point of presence database for online entities having access to a collaboration software application which satisfy said search pattern, (page 3, 1.2.3, page 126, figure 4-22 and table 4-5);

presenting a list of said resulting online entities, (page 126, 1<sup>st</sup> paragraph);

receiving a selection of at least one of said resulting online entities contained within said list, (page 126, 1<sup>st</sup> paragraph); and

establishing a software-enhanced communication session between said user and said selected online entity, (page 3, 1.2.3, page 126, figure 4-22 and table 4-5).

In reference to claims 13 and 31, Lotus Sametime teaches the method / system of claims 12 and 30 further comprising:

displaying a graphical user interface for an instant messaging component of said collaboration software application, (page 151, figure 5-28),

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wherein said graphical user interface provides a user selectable search option; receiving a user selection for said search option, (page 201); and

responsively presenting search input fields within said graphical user interface, wherein said search pattern is based upon data input into said search input fields, (page 201, input box).

In reference to claims 14 and 32, Lotus Sametime teaches the method / system of claims 13 and 31 wherein:

said software-enhanced communication session includes a type of communication other than instant messaging, (page 150, 5.5 – page 151).

In reference to claims 15 and 33, Lotus Sametime teaches the method / system of claims 12 and 30 wherein:

said collaboration software application is a Lotus Sametime (TM) type application, (page 15).

In reference to claim 16, Lotus Sametime teaches a method comprising:

a collaboration server configured to coordinate collaboration operations between a plurality of geographically disperse software components, (page 9, 1.3.3, 4<sup>th</sup> paragraph); and



at least one client side collaboration application that includes a search engine, said search engine configured to query said collaboration software system for online entities, (page 121, figures 4-19 and 4-20),

wherein said client side collaboration application contains a graphical user interface permitting user customization of said search engine, (page 121, figures 4-19 and 4-20).

In reference to claim 17, Lotus Sametime teaches the method / system of claim 16 wherein:

said graphical user interface comprises an instant messenger view and a search view, (page 201, figure 6-7).

In reference to claim 18, Lotus Sametime teaches the method / system of claim 17 wherein:

said search view is directly initiated from said instant messenger view, and wherein said search view utilizes said search engine, (page 201, figure 6-7 and item 2).

4. Claims 1, 3-5, 19 and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Berger et al., (hereinafter Berger), (US Publication No. 2004/0267887).

In reference to claims 1 and 19, Berger teaches a method / system comprising:  
providing a collaborative computing system comprising at least one instant messaging client, (paragraph 27);

initializing said instant message client within a graphical user interface of said collaborative computing system, (paragraph 28);

receiving a search initializing action from said graphical user interface;  
responsive to said receiving step, (paragraph 33),

presenting search input fields within said graphical user interface, (paragraph 33);

receiving input via said input fields that specifies a search pattern, (paragraph 33);

searching at least one record source for online entities that satisfy said search pattern, (paragraph 33); and

displaying a search result from said searching step within said graphical user interface, (paragraph 33).

In reference to claims 3 and 21, Berger teaches the method / system of claims 1 and 19 wherein:

said search initializing action comprises at most two user inputs, (paragraph 33).

In reference to claims 4 and 22, Berger teaches the method / system of claims 3 and 21 further comprising:

displaying a menu option within said graphical user interface for said instant message client, wherein said menu option is configured to initiate said search view, (paragraph 33).

In reference to claims 5 and 23, Berger teaches the method / system of claims 3 and 21 further comprising:

providing a keyboard combination to initiate said search view, whereby said keyboard combination is a hot-key combination, (paragraph 35, 'or selecting a designated key from the data processing device's keyboard').

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Goodchild whose telephone number is (571) 270-1589. The examiner can normally be reached on Monday - Friday / 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WJG  
07/10/2007



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